APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,941	06/25/2001	Theresa A. Burkes	10008291-1	9288

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EXAMINER
BROOKS, MATTHEW L

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/888,941	BURKES ET AL.
	Examiner	Art Unit	
	Matthew L. Brooks	3629	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 February 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>25 June 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Drawings

1.   The drawings are objected to under 37 CFR 1.83(a). The drawings must

show every feature of the invention specified in the claims. Therefore, for

example:

the reading the timestamp from memory (claim 2) and outputting of the

timestamp (claims11, 13-15, 20, and 21 must be shown or the feature(s)

canceled from the claim(s). (note: there may be others) No new matter should

be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are

required in reply to the Office action to avoid abandonment of the application.

Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is

being amended. The figure or figure number of an amended drawing should not

be labeled as "amended." If a drawing figure is to be canceled, the appropriate

figure must be removed from the replacement sheet, and where necessary, the

remaining figures must be renumbered and appropriate changes made to the

brief description of the several views of the drawings for consistency. Additional

replacement sheets may be necessary to show the renumbering of the remaining

figures. Each drawing sheet submitted after the filing date of an application must

be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the

next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 2nd

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 16 and 17 recites the limitation "peripheral". It is also very

ambiguous to the Examiner Applicant's lax switching of the term "product" and

"peripheral" with in claims 15 through 20. There is insufficient antecedent basis

for this limitation in the claim.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be

within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law

of nature, natural phenomena) that do not apply, involve, use, or advance the

technological arts fail to promote the "progress of science and the useful arts"

(i.e., the physical sciences as opposed to social sciences, for example) and

therefore are found to be non-statutory subject matter. For a process claim to

pass muster, the recited process must somehow apply, involve, use, or advance

the technological arts.

Mere intended or nominal use of a component, albeit within the

technological arts, does not confer statutory subject matter to an otherwise

abstract idea if the component does not apply, involve, use, or advance the

underlying process.

In the present case, the Applicants steps can easily be accomplished

without the use of a computer and is merely defining a warranty start date, filing a

warranty card (timestamp) and storing the info in a file cabinet or in ones head.

This may be done on a piece of paper at a person's desk or even in one's head.

All of the above can be done with out the use of technology or a computer.

Appropriate action is required.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially
created doctrine grounded in public policy (a policy reflected in the statute) so as
to prevent the unjustified or improper timewise extension of the "right to exclude"
granted by a patent and to prevent possible harassment by multiple assignees.
See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re
Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164
USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644
(CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may
be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent is shown to
be commonly owned with this application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may
sign a terminal disclaimer. A terminal disclaimer signed by the assignee must
fully comply with 37 CFR 3.73(b).

3.   **Claims 1-4, 10- 12, and 15** are rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims

1-20 of U.S. Patent No. 6,798,719 (Muta). Although the conflicting claims are not

identical, they are not patentably distinct from each other because the Applicant

is claiming an obvious variation of the invention defined in the claims of the

patent.

4.   With respect to **Claim 1**: Muta discloses

        A method for determining a warranty start date for a product comprising

the steps of: defining a warranty start event ("event occurs"); generating a

timestamp with the product after detection of the occurrence of said warranty

start event; and, storing said timestamp in a memory (Column 6, 50-62).

5.   With respect to **Claim 2**: Muta discloses

        the step of reading said timestamp from said memory to determine the

warranty start date (Column 7, 1-10).

6.   With respect to **Claim 3**: Muta discloses

        wherein said memory is internal to the product (Column 6, 45-50).

7.   With respect to **Claim 4**: Muta discloses

        wherein said step of generating a timestamp comprises obtaining said

timestamp from an internal clock (Column 6, 50-60 "RTC").

8.   With respect to **Claim 10 and 11**: Muta discloses

wherein said step of storing said timestamp in said memory further

comprises encrypting said timestamp and outputting said encrypted timestamp

with the product. (Column 6, 52 "encoded" and "display").

9.   With respect to **Claim 12**: Muta discloses

the step of continuously searching for occurrence of said warranty start

event (Column 6, 50-60 wherein the counting of and reading of the event

constitutes searching).

10.   With respect to **Claim 15**: Muta discloses

A computer program product for causing a product to determine a

warranty start date for the product, the computer program product comprising

computer readable instructions embedded in a computer readable medium,

the instructions when executed by the product causing the product to:

retrieve a stored warranty start event definition from a memory (Column 6, 50-

64);

generate a timestamp with the product after detection of the occurrence of

said warranty start event (Column 6, 50-65);

store said timestamp in a memory (Column 7, 5-10); and,

output said timestamp from said memory when prompted to determine the

warranty start date (Column 6, 40-60).

11.   **Claims 5-9, 13-14, and 16-21** are rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims

1-20 of U.S. Patent No. 6,798,719 (Muta). Although the conflicting claims are not

identical, they are not patentably distinct from each other because they are

obvious variants of each other.   Muta discloses all of the limitations as discussed

above, including a method/system/program of and for creating a warranty start

date for an electronic device (*which includes a photocopier*) comprising the steps

of generating a timestamp after the detection of the occurrence of a warranty

start event (wherein the warranty start event_is triggered by the number of a

times an "event" occurs) and storing timestamp in a memory.

Muta does not disclose that the electronic device obtains the time stamp

over a network and storage of the date in a remote memory to the device

accessed by the same network.

In determining the obviousness of applying what is generally known in the

warranty registration industry to what is known in the world of the Internet one

must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189

USPQ 257 (1976)). The Internet, to one ordinarily skilled in the art, for some time

now is recognized as a vehicle in which information is shared from computer to

computer. A typical example would be for one computer to access and download

a current time from another computer located at a different site than the first.

Using a separate database or memory for storing such information is widely

known by the use of database maintenance techniques. Also, the warranty

registration industry has utilized computers for years to mark the start the time

that the warranty start event occurs accounts and to store this data in separate

databases other than that of the actual product. Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to have

utilized the Internet to access via network a timeserver and then to store the time

stamp in a separate memory other than that of the product. The desirability to do

this is clearly to start the warranty registration with an accurate date as possible

and to have the start thereof stored in a memory separate from the actual device

so incase of a destruction of the product the data will remain.

12.   Claims 1-21 are directed to the same invention as that of claims 1-20 of

commonly assigned patent number 6,798719. The issue of priority under 35

U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be

resolved.

Since the U.S. Patent and Trademark Office normally will not institute an

interference between applications or a patent and an application of common

ownership (see MPEP § 2302), the assignee is required to state which entity is

the prior inventor of the conflicting subject matter. A terminal disclaimer has no

effect in this situation since the basis for refusing more than one patent is priority

of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of

abandonment of this application.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S.

patent resulting directly or indirectly from an international application filed before

November 29, 2000. Therefore, the prior art date of the reference is determined

under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C.

102(e)).

14.   Claims **1-4, 10- 12, and 15** rejected under 35 U.S.C. 102(e) as being

anticipated by Muta.

The applied reference has a common Assignee with the instant

application. Based upon the earlier effective U.S. filing date of the reference, it

constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C.

102(e) might be overcome either by a showing under 37 CFR 1.132 that any

invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an

appropriate showing under 37 CFR 1.131.

15.   With respect to **Claim 1**: Muta discloses

A method for determining a warranty start date for a product comprising

the steps of: defining a warranty start event ("event occurs"); generating a

timestamp with the product after detection of the occurrence of said warranty

start event; and, storing said timestamp in a memory (Column 6, 50-62).

16.   With respect to **Claim 2**: Muta discloses

the step of reading said timestamp from said memory to determine the warranty start date (Column 7, 1-10).

17.   With respect to **Claim 3**: Muta discloses

wherein said memory is internal to the product (Column 6, 45-50).

18.   With respect to **Claim 4**: Muta discloses

wherein said step of generating a timestamp comprises obtaining said timestamp from an internal clock (Column 6, 50-60 "RTC").

19.   With respect to **Claim 10 and 11**: Muta discloses

wherein said step of storing said timestamp in said memory further comprises encrypting said timestamp and outputting said encrypted timestamp with the product. (Column 6, 52 "encoded" and "display").

20.   With respect to **Claim 12**: Muta discloses

the step of continuously searching for occurrence of said warranty start event (Column 6, 50-60 wherein the counting of and reading of the event constitutes searching).

21.   With respect to **Claim 15**: Muta discloses

A computer program product for causing a product to determine a warranty start date for the product, the computer program product comprising computer readable instructions embedded in a computer readable medium,

the instructions when executed by the product causing the product to:

retrieve a stored warranty start event definition from a memory (Column 6, 50-64);

generate a timestamp with the product after detection of the occurrence of

said warranty start event (Column 6, 50-65);

store said timestamp in a memory (Column 7, 5-10); and,

output said timestamp from said memory when prompted to determine the

warranty start date (Column 6, 40-60).

Claim Rejections - 35 USC § 103

22.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

23.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1,

148 USPQ 459 (1966), that are applied for establishing a background for

determining obviousness under 35 U.S.C. 103(a) are summarized as follows: .

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at
      issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
      obviousness or nonobviousness.

24.   Claims **5-9, 13-14, and 16-21** are rejected under 35 U.S.C. 103(a) as

being obvious over Muta et al.

The applied reference has a common Assignee with the instant

application. Based upon the earlier effective U.S. filing date of the reference, it

constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C.

103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any

invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not an invention "by another"; (2) a

showing of a date of invention for the claimed subject matter of the application

which corresponds to subject matter disclosed but not claimed in the reference,

prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3)

an oath or declaration under 37 CFR 1.130 stating that the application and

reference are currently owned by the same party and that the inventor named in

the application is the prior inventor under 35 U.S.C. 104, together with a terminal

disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be

overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as

prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and §

706.02(l)(2).

25.   Muta discloses all of the limitations as discussed above, including a

method/system/program of and for creating a warranty start date for an electronic

device (which includes a photocopier) comprising the steps of generating a

timestamp after the detection of the occurrence of a warranty start event

(wherein the warranty start event is triggered by the number of a times an "event"

occurs) and storing timestamp in a memory.

       Muta does not disclose that the electronic device obtains the time stamp

over a network and storage of the date in a remote memory to the device

accessed by the same network.

       In determining the obviousness of applying what is generally known in the

warranty registration industry to what is known in the world of the Internet one

must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189

USPQ 257 (1976)). The Internet, to one ordinarily skilled in the art, for some time

now is recognized as a vehicle in which information is shared from computer to

computer. A typical example would be for one computer to access and download

a current time from another computer located at a different site than the first.

Using a separate database or memory for storing such information is widely

known by the use of database maintenance techniques. Also, the warranty

registration industry has utilized computers for years to mark the start the time

that the warranty start event occurs accounts and to store this data in separate

databases other than that of the actual product. Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to have

utilized the Internet to access via network a timeserver and then to store the time

stamp in a separate memory other than that of the product. The desirability to do

this is clearly to start the warranty registration with an accurate date as possible

and to have the start thereof stored in a memory separate from the actual device

so incase of a destruction of the product the data will remain.

Conclusion

26.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

A. 6,519,470 (Rydbeck) which teaches the continuous searching and a

warranty registration center (remote memory) along with a timestamp received

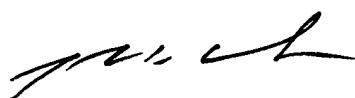over a network wherein the above is triggered by warranty start event.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB
9/14/2005

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
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